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APPLICATION NO. FILING DATE ATTORNEY DOCKET NO. CONFIRMATION NO. FIRST NAMED INVENTOR 10/624,678 07/23/2003 Hikaru Sugita 5988-054-27 6692 **EXAMINER** 02/17/2005 7590 Supervisor, Patent Prosecution Services LEE, RIP A PIPER RUDNICK LLP **ART UNIT** PAPER NUMBER 1200 Nineteenth Street, N.W. Washington, DC 20036-2412 1713

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

			UD
	Application No.	Applicant(s)	
Office Action Summary	10/624,678	SUGITA ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	
The MAILING DATE of this communication a Period for Reply	ppears on the cover sheet v	vith the correspondence address	
A SHORTENED STATUTORY PERIOD FOR REP THE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a relation of the period for reply is specified above, the maximum statutory period for reply within the set or extended period for reply will, by state Any reply received by the Office later than three months after the mail earned patent term adjustment. See 37 CFR 1.704(b).	N. 1.136(a). In no event, however, may a eply within the statutory minimum of the od will apply and will expire SIX (6) MO ute, cause the application to become A	reply be timely filed rty (30) days will be considered timely. NTHS from the mailing date of this communication BANDONED (35 U.S.C. § 133).	າ.
Status			
 1) ⊠ Responsive to communication(s) filed on 22 2a) ⊠ This action is FINAL. 2b) □ Th 3) □ Since this application is in condition for allow closed in accordance with the practice under 	nis action is non-final. vance except for formal ma		;
Disposition of Claims			
 4) Claim(s) 1-9,11 and 12 is/are pending in the 4a) Of the above claim(s) is/are withdr 5) Claim(s) 1-4, 6, 7, 9, 11 and 12 is/are allowe 6) Claim(s) 5 and 8 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and 	rawn from consideration.		
Application Papers			
9) The specification is objected to by the Examination The drawing(s) filed on is/are: a) and a specificant may not request that any objection to the Replacement drawing sheet(s) including the correction of the specific to be specification as objected to by the specific to be specification in the specific transfer of	ccepted or b) objected to be drawing(s) be held in abeya ection is required if the drawing	nce. See 37 CFR 1.85(a). g(s) is objected to. See 37 CFR 1.121(d	d).
Priority under 35 U.S.C. § 119			• • •
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority application from the International Bure * See the attached detailed Office action for a list	nts have been received. nts have been received in A iority documents have been eau (PCT Rule 17.2(a)).	Application No received in this National Stage	
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 11-22-2004.	Paper No.	Summary (PTO-413) (s)/Mail Date Informal Patent Application (PTO-152)	

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DETAILED ACTION

This office action follows a response filed on November 22, 2004. Applicants have amended claims 5 and 6. Claim 10 was canceled, and new claims 11 and 12 were added.

Claim Rejections - 35 USC § 102

- 1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 2. Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-161111 to Murata *et al.* for the same reasons set forth in the previous office action.

Breifly, Murata *et al.* discloses radiation sensitive resin compositions comprising units derived from styrene substituted with –CH₂OCOOR and –CH₂OCH₂CH₂COOR groups (see structures on page 4). These groups qualify as "acyl group," as recited in the present claims. Solvents are discussed in paragraph [0057], and compositions of polymer and solvent are used to cast resist films on silicon wafers (see paragraph [0059]). Use of acid generating compounds is discussed extensively on pages 8 and 9. In sum, all aspects of the present claims are taught adequately in the prior art of Murata *et al*.

Allowable Subject Matter

3. The following is a statement of reasons for the indication of allowable subject matter: Claims 1-4 and 7 are allowed, as indicated previously. Claims 6, 9, 11, and 12 are allowed over all cited references in this and previous office actions. None of the references discloses the subject matter of the present invention.

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Response to Arguments

4. Applicants traverse the rejection of claims 5 and 8 as being under 35 U.S.C. 102(b) as being anticipated by JP 6-161111 to Murata *et al*. Applicant's arguments have been considered fully, but they are not persuasive. As elucidated in paragraph 2 of this office action, the embodiments shown in the prior art contain "acyl groups," as recited in the present claims. Therefore, the subject matter of the present claims is still anticipated by the reference. Consequently, the rejection has not been withdrawn.

Information Disclosure Statement

5. The information disclosure statement filed November 11, 2003 has been entered into the record.

Prior Art

6. EP 1 205 805 (corresponding US-PG publication 2002/0086934) to Kawaguchi *et al.* has been cited in a foreign search report as an "X" reference. The patent discloses polymers derived from acenaphthylene derivatives in which substituent R¹ is hydrogen, alkyl, alkenyl, hydroxyl, amino, phenyl, acyl, carboxyl, sulfonic acid, mercapto, *etc.* The reference does not disclose or reasonably suggest use of ROCH₂- groups.

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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February 14, 2005

DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700